

REMARKS

In the Office Action¹, the Examiner:

rejected claims 1-32 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite;

rejected claims 1-20 under 35 U.S.C. § 101 as allegedly drawn to non-statutory subject matter;

rejected claims 1-8, 10, 11, 13-18, 20, 21, and 23-32 under 35 U.S.C. § 103(a) as allegedly unpatentable over *B2B Collaborative Commerce with Sametime, QuickPlace and WebSphere Commerce Suite* authored by Nielsen ("Nielsen") in view of *OAGIS implementation using the ebXML, CPP, CPA, and BPSS specifications v. 1.0* authored by Dubray ("Dubray");

rejected claims 9, 19, and 22 under 35 U.S.C. § 103(a) as allegedly unpatentable over Nielsen and Dubray in view of a web page news release entitled *United Nations and Oasis Join Forces to Produce Global XML Framework for Electronic Business* published by ebXML ("ebXML"); and

rejected claim 12 under 35 U.S.C. § 103(a) as allegedly unpatentable over Nielsen and Dubray in view of Official Notice.

Claims 1-32 remain pending.

I. Rejection under 35 U.S.C. § 112, second paragraph

Applicant respectfully traverses the rejection of claims 1-32 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Specifically, the Office Action alleges that, with respect to claims 1, 21, 23, and 25, the "Examiner is not clear how . . . a predefined sequence [can] be modified according to an input that comes after the predefined sequence in the method steps." Office Action p. 2.

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Claim 1 recites “predefining a sequence of business transactions to be executed in a first computer, the sequence being predefined according to received sequence modification input.” Contrary to the allegations of the Office Action, the claimed “predefined sequence” is not **modified** by an input that comes after the “predefined sequence,” the actual “sequence” is “**predefined**” based on “received sequence modification input” as part of the “predefining” step. In other words, claim 1 does not recite that a “sequence” is “predefined” and then later modified. The “predefining” itself is based on “received sequence modification input.”

Thus, Applicant respectfully submits that claim 1 is both definite and clear. If the Examiner continues to feel that the claim is unclear, the Examiner is invited to contact the undersigned for a telephonic interview. Claims 21, 23, and 25 contain elements similar to those of claim 1 and are both clear and definite for reasons similar to those discussed above in connection with claim 1. Inasmuch as no explanation for the rejection of the dependent claims has been provided and the independent claims are both clear and definite, Applicant submits that the dependent claims are clear and definite. Thus, the rejection should be withdrawn.

II. Rejection under 35 U.S.C. § 101

Applicant respectfully traverses the rejection of claims 1-20 under 35 U.S.C. § 101 as allegedly drawn to non-statutory subject matter. Specifically, the Examiner alleges that under the “broadest reasonable interpretation and in light of the specification (see paragraphs 0067 and 0076 [of the published version of this application]), claims 1-20 as recited, a computer-readable recording medium can be

interpreted to be embodied on abstract medi[a] such as carrier waves and signals.”

Office Action p. 3.

Paragraphs [071] and [080] have been amended. While Applicant does not concede that a “signal” could constitute a “computer-readable recording medium,” in order to expedite prosecution, the specification has been amended. Further, Applicant notes that a “carrier” is defined in paragraph [080] as “implemented as any computer readable medium, such as a medium largely explained above (cf. memory 920). Generally, carrier 970 is an article of manufacture having a computer readable medium with computer readable program code to cause the computer to perform methods of the present invention.” Specification paragraph [080]. Thus, the term “carrier” does not include “carrier waves and signals.”

Accordingly, claims 1-20 are not directed to non-statutory subject matter in light of the specification. Applicant respectfully requests that the rejection be withdrawn.

III. Rejections under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 1 under 35 U.S.C. § 103(a) as allegedly unpatentable over Nielsen and Dubray. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore,

“[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1 recites, for example, “creating a business schema by combining the predefined sequence with at least one document assigned to the sequence of business transactions, the at least one document to be combined with the predefined sequence of business transactions being selected according to a received context selection for identifying the at least one document.” The Office Action correctly recognizes that Nielsen fails to disclose or suggest this feature of claim 1. Office Action p. 7. The Office Action does, however, allege that Dubray remedies this deficiency of Nielsen. *Id.* But, this allegation is not correct.

In particular, the Office Action alleges that Dubray discloses:

creating a business schema by combining the predefined sequence with at least one document assigned to the sequence of business transactions, the at least one document to be combined with the predefined sequence of business transaction being selected according to a received context selection for identifying the at least one document (Figures 8-12 illustrate[s] business schema[] e.g., collaboration activity diagram, Figures 4 and 7 illustrate[] assigning a document to each business transaction e.g., RespondingBusinessActivity -> Document Envelope -> Attachment: business document, page 12, figure, illustrates a representation of a collaboration definition with a choreography of business transaction with a document flow, Figure 2, illustrates a business schema of requesting and responding [to] an activity with at least one document assigned and Figure 3 illustrates another business schema with predefine[d] sequence between Purchasing and Order Management Sales with at least one document assigned 'RFQ' and 'Quote' to a predefined sequence of business transaction e.g., request for quotation, '10.GETLIST QUOTE' which is a received context selection for identifying at least one document 'quote') (emphasis added). Office Action pp. 8-9.

First, Applicant notes that the Office Action alleges that Dubray discloses “creating a business schema,” but never actually shows where Dubray allegedly discloses this “creati[on].” As outlined by emphasis above, the Office Action does not allege that any “creati[on]” of a business schema takes place in Dubray, it merely alleges that Dubray “illustrates business schema[.]” Since Dubray does not disclose “creating a business schema,” as claimed, a *prima facie* case of obviousness has not been established because the Office Action has not shown that any alleged “business schema” in Dubray are “creat[ed] . . . by combining the predefined sequence with at least one document assigned to the sequence of business transactions.” On the contrary, the Office Action alleges that “business schema” exist in Dubray and then are “assign[ed] a document.” Thus, the any alleged “business schema” in Dubray are not the result of “combining the predefined sequence with at least one document,” consistent with the elements of claim 1.

Second, the Office Action alleges that in Dubray “Figure 2 illustrates . . . business schema of requesting and responding [to] an activity with at least one document assigned.” *Id.* However, Dubray does not disclose or suggest the elements of the claims. For example, even if the Office Action is correct, and Figure 2 of Dubray does “illustrate[] . . . business schema . . . with at least one document assigned,” the Office Action has not shown that the alleged “business schema” in Figure 2 is the “predefined sequence” that is “predefined according to sequence modification input.” The Office Action alleges that the alleged “document” is “combined” with the “business schema,” not with the “predefined sequence.” Thus, the Office Action has not shown and Dubray does not disclose or suggest, the claimed “creating a business schema by combining the predefined sequence with at least one document assigned to the sequence of business transactions.”

Third, the Office Action alleges that a “predefined sequence” is taught by Dubray in Figure 8 that “illustrates that based on the process purchase order business transaction, Responding Activity from a seller, there are three sequences to follow.” Office Action p. 8. Thus, here the Office Action seemingly alleges that the “predefined sequence” is one of “Ack PO,” “Reject PO,” or “Back Order.” *See Dubray*, Figure 8. However, if the three “defined sequences” constitute a “**predefined** sequence,” which Applicant submits that they do not, there is no disclosure or suggestion that “**predefining**” these sequences is based on “received modification input.” In fact, contrary to the Office Action’s assertions, Dubray cannot disclose “predefining a sequence” that is “predefined according to received sequence modification input” when the alleged “modification input” (e.g., which sequence will be performed) is not

determined until **after** the activity has been requested and the sequence has begun, as shown in Figure 8 of Dubray.

Fourth, as discussed immediately above, the Office Action has alleged that the “predefined sequence” is one of the three possible sequences (“Ack PO,” “Reject PO,” or “Back Order”) shown in Figure 8 of Dubray. Office Action p. 8. However, the Office Action next alleges, with respect to the claimed “creating a business schema by combining the predefined sequence with at least one document assigned to the sequence of business transactions,” that the alleged “predefined sequence” is illustrated in Figure 3 of Dubray “between Purchasing and Order Management Sales with at least one document assigned “RFQ” and “Quote” to a predefined sequence of business transaction.” Office Action p. 9. Thus, in essence, the Office Action states that the alleged “predetermined sequence” is one of “Ack PO,” “Reject PO,” or “Back Order” but then later inconsistently states that the “predetermined sequence” is between “Purchasing and Order Management Sales.” Applicant respectfully submits that a *prima facie* case of obviousness has not been established because the Office Action is inconsistent, without explanation for the inconsistencies, in its interpretation of Dubray. The Patent Office may not interpret similar elements differently in the same claim. See Glaxo Wellcome Inc. v. Impax Labs. Inc., 356 F.3d 1348, 1356 (Fed. Cir. 2004)

Finally, with respect to the claimed “document,” the Office Action has still not shown that the “document to be combined with the predefined sequence of business transactions [is] selected according to a received context selection for identifying the at least one document.” Here, as before, the Office Action is inconsistent. On pages 8-9 of the Office Action, the Patent Office states that the alleged “document” is an

“attach[ed] business document” shown in Figures 4 and 7 of Dubray. However, on page 9 of the Office Action, the Patent Office states that Figure 3 illustrates an “RFQ” and “Quote” that allegedly constitute a document and that the “10. GETLIST QUOTE” allegedly constitutes the claimed “context selection” of the document.

Either the Office Action has impermissibly interpreted similar elements of the claims differently (e.g., the claimed “document” is disclosed as the “attached business document” on page 8-9 but is the “Quote” on page 9), or the Office Action has failed to show that Dubray discloses a “context selection” for the “attach[ed] business document.” The “10. GETLIST QUOTE” cannot, on its face, be said to disclose or suggest a “context selection” for the “attach[ed] business document.” Such an allegation would extend well beyond the broadest reasonable interpretation of the claims.

However, even if the sequence shown in Figure 3 of Dubray “between Purchasing and Order Management Systems” could constitute a “pre-defined sequence,” which Applicant does not concede, the “Quote” cannot constitute a “document.” Nothing in Dubray discloses or suggests that the “Quote” could constitute a “document.” There is nothing in Dubray that discloses or suggests a “Quote” is anything but data. And, even the allegation that a “Quote” could constitute a document is in direct contrast with Figures 4 and 7 of Dubray which, as the Office Action admits, shows assigning a “document” to a “business transaction.” Dubray does not disclose or suggest that a “Quote” in Figure 3 could constitute a “document” as shown in Figures 4 and 7.

Therefore, for at least the foregoing reasons, Dubray does not remedy the deficiencies of Nielsen at least because the Office Action is not only inconsistent with the alleged teaching of Dubray but also because Dubray fails to disclose or suggest the claimed “creating a business schema by combining the predefined sequence with at least one document assigned to the sequence of business transactions, the at least one document to be combined with the predefined sequence of business transactions being selected according to a received context selection for identifying the at least one document.” Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 1. The rejection is therefore improper and should be withdrawn.

Independent claims 21, 23, and 25 although of a scope different from that of claim 1, recite features similar to those discussed above in connection with claim 1. Applicant asserts that independent claims 21, 23, and 25 are allowable over Nielsen and Dubray for reasons similar to those discussed above in connection with claim 1. Accordingly, Applicant submits that claims 21, 23, and 25 are allowable and requests that the rejection of claims 21, 23, and 25 be withdrawn.

Claims 2-8, 10, 11, 13-18, 20, 24, and 26-32 depend from one of independent claims 1, 21, 23, or 25. Inasmuch as these claims depend from an allowable independent claim, these claims are allowable at least due to their respective dependencies. Applicant respectfully requests that the rejection of these claims be withdrawn.

Applicant respectfully traverses the rejection of claims 9, 12, 19, and 22 under 35 U.S.C. § 103(a) over Nielsen and Dubray in view of one of ebXML or Official Notice. The Office Action acknowledges that Nielsen fails to disclose or suggest “creating a

business schema by combining the predefined sequence with at least one document assigned to the sequence of business transactions, the at least one document to be combined with the predefined sequence of business transactions being selected according to a received context selection for identifying the at least one document.”

Office Action p. 7-8. The Office Action incorrectly relies on Dubray to remedy the deficiency of Nielsen as discussed above with respect to independent claim 1. Since neither Official Notice nor ebXML remedy the deficiencies of Nielsen and Dubray, the rejection of dependent claims 9, 12, 19, and 22 is incorrect and should be withdrawn.

Furthermore, claims 9, 12, 19, and 22, depend from claim 1 and are allowable at least due to their dependency. Accordingly, Applicant respectfully requests that the rejection of dependent claims 9, 12, 19, and 22 be withdrawn.

CONCLUSION


In view of the foregoing, Applicant respectfully requests reconsideration of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 21, 2010

By: 

Travis R. Banta
Reg. No. 60,498
(202) 408-4000